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Our Case No. 10710-623
(PTG 0633 PUS2)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Dils et al.

Serial No. 10/731,612

Filing Date: December 9, 2003

For ERGONOMIC MITER SAW
HANDLE

Examiner: Nguyen

Group Art Unit No. 3724

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the final Office Action mailed November 13, 2006, Applicants have filed this Pre-Appeal Brief Request for Review, as well as the accompanying Notice of Appeal. Applicants wish to avail themselves of the expedited PTO procedure for appeals in accordance with the USPTO's Official Gazette notice dated July 12, 2005. The current claims of record in this application were filed as an Amendment on August 28, 2006.

Claims 1 and 4 are rejected under 35 U.S.C. § 102(e) as anticipated by Bean. Applicants respectfully traverse the rejection because Bean does not disclose all of the

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limitations of independent claim 1, let alone dependent claim 4.

In rejecting claims 1 and 4, the Examiner builds upon what can be rationally discerned from the four corners of Bean by adding structure that the Examiner alleges is found in a commercial embodiment of the miter saw depicted in Bean's design drawings. Specifically, the Examiner compares measurements taken from Bean's patent drawings with measurements allegedly taken from a commercial embodiment miter saw to conclude that Bean discloses the claimed palm pad. The Examiner's actions are erroneous. Initially, "it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue." *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1491 (Fed. Cir. 2005) (citing *Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956; 55 USPQ2d 1487, 1491 (Fed. Cir. 2000); See MPEP § 2125. Bean does not include any statements that the drawings therein are drawn to scale, let alone the scale of the drawings. Accordingly, any attempt to glean a scale from Bean's drawings is erroneous.

The Examiner made no attempt to show on the record that the commercial embodiment of the miter saw asserted by the Examiner is prior art, let alone that it is constructed with the exact same design disclosed in Bean's drawings. Specifically, the Examiner does not provide any showing on the record that the commercial embodiment miter saw was in public use or on sale in the United States prior to January 29, 2001 in accordance with 35 U.S.C. § 102. Moreover, the Examiner's description of the "real miter saw" is deficient because the Examiner does not provide Applicants with sufficient information to evaluate the accuracy of the Examiner's assertions regarding the various dimensions of the commercial miter saw vis-à-vis the drawings in Bean. Without this minimum information, the rejection must be withdrawn.

Further, the Examiner's comparison of the commercial embodiment miter saw with the disclosure of Bean is inappropriate. In the "Response to Arguments" section of the final rejection, the Examiner cites to MPEP § 1502 as a point of authority for his actions. This section of the MPEP states that "[d]esign is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance

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result of a method." (Emphasis Added). This section merely stands for the proposition that a design patent must be directed to a definite object, and not just a surface treatment or similar surface ornamentation on an object. This section does not stand for the proposition that a design patent inherently references a commercial embodiment, or that a design patent can be freely compared to an allegedly similar commercial embodiment. Considering the quoted section of the MPEP to stand for anything more than the plain language of the section would be contrary to the precedential authority of the Federal Circuit and the Patent Act and therefore is improper. Neither the Patent Act, nor the patent regulations include any requirements that a design patent relate to a specific commercial embodiment, nor that there must be an actual reduction to practice of a device depicted in a design patent.

It is inappropriate to add limitations or structure to a design patent from a commercial embodiment that is similar to the design patent. See *Berry Sterling Corp. v. Pescor Plastics, Inc.*, 122 F.3d 1452 (Fed. Cir. 1997); *Continental Plastic v. Owens Brockway Plastic*, 141 F.3d 1073 (Fed. Cir. 1998). In *Berry Sterling*, the Federal Circuit reversed the grant of summary judgment of invalidity of a design patent on functionality grounds because the Federal Circuit found that the district court had improperly considered functional aspects of a commercial embodiment of the design patent rather than the structure specifically disclosed and claimed in the design patent. *Id.* at 1455. Similarly, the Examiner improperly attempts to import structure from a commercial embodiment miter saw into a design patent to assert that the claimed structure is disclosed in Bean. The Examiner's actions and his interpretation of MPEP § 1502 are contrary to *Berry Sterling* and therefore are improper. Because it is improper to interpret Bean to include structural aspects of a commercial embodiment miter saw, the current rejection must be evaluated solely on Bean's disclosure.

FIGs. 4 and 6 of Bean provide the best views of the handle of Bean's miter saw. Bean does not disclose or suggest a grip portion sized for a user's fingers to wrap thereabout and a palm pad portion extending outwardly from the grip portion for a distance sufficient to underlie the heel portion of the palm of the user's hand. In contrast, Bean discloses a grip portion that extends from an arm. The grip includes structure that appears to be a trigger that extends inwardly from a front member that is oriented generally

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perpendicular to the arm. The front member includes a gradual arcuate outer edge along the length of the front member. Neither the grip nor the front member includes any structure that could rationally be considered to be a palm pad portion extending outwardly from the grip portion a distance sufficient to underlie the heel portion of the palm of the user's hand. Accordingly, Applicants respectfully request that the rejection of claims 1 and 4 be withdrawn.

Claim 2 is rejected as obvious over Bean in view of Svetlik and claim 3 is rejected as obvious over Bean in view of Bidanset. Applicants respectfully traverse. Neither Bean nor the secondary references Svetlik and Bidanset disclose all of the limitations, either alone or in combination, of independent claim 1, let alone dependent claims 2 and 3, respectively. Accordingly, Applicants respectfully request that the rejection of dependent claims 2 and 3 be withdrawn.

Claims 1, 4-9, and 22-23 are rejected as obvious over Brunson in view of Bean and Pause. Applicants respectfully traverse. Initially, the Examiner has not provided a suitable motivation to combine each of Brunson, Bean, and Pause, and accordingly has not established a *prima facie* case of obviousness. Applicants can only conclude that the combination of the cited references was made with improper hindsight to the subject application. The Examiner's statement that it would have been obvious to incorporate Pause's rotatable joint in Brunson's saw "to increase the adjustability of the handle in the Brunson's [sic] saw" is not a sufficient motivation to combine in accordance with current Federal Circuit case law. See Office Action dated November 13, 2006, p. 7, line 8. Brunson does not provide any motivation to allow for the orientation of its handle to be modified. Pause discloses that the handle of a hand saw may be rotated with respect to the saw blade "when an angular cut is to be made in a position that is not easily accessible" Pause, II. 75-77. The basis for allowing rotation of the Pause handle is not germane to the Brunson saw because there is not a handle position on the Brunson miter saw that is not easily accessible. Accordingly, there is no motivation to combine Brunson and Pause within the references themselves.

While Applicants acknowledge that a motivation to combine can be shown by the level of knowledge of those of skill in the art, the Examiner must place sufficient

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objective evidence of this general knowledge on the record to satisfy his burden in providing a *prima facie* case of obviousness. See *In re Kahn*, 441 F.3d 977 (Fed. Cir. 2006) (citing *In re Lee*, 277 F.3d 1338, 1343-45 (Fed. Cir. 2002); *In re Rouffet*, 149 F.3d 1350, 1357-59 (Fed. Cir. 1998)). The Examiner has not satisfied this evidentiary burden and the obviousness rejection must be withdrawn. In rejecting the claims, the Examiner provides only a conclusionary statement that one of skill in the art would modify the Brunson miter saw with Pause's rotatable joint to "increase the adjustability of the handle in the Brunson's [sic] saw." Office Action dated November 13, 2006, page. 7, line 8. The Examiner did not provide any additional objective evidence that the state of the art was such that the proposed combination was possible, let alone that one of ordinary skill would have contemplated such a combination based on their general level of knowledge. Accordingly, because the Examiner has not provided a *prima facie* case of obviousness of claims 1, 4-9, and 22-23, Applicants respectfully request that this rejection be withdrawn. Dependent claim 24 was rejected as obvious based on the references discussed with respect to claims 22 and 23 above, in view further of Kaley. Kaley does not provide the absent motivation to combine Brunson and Pause, nor does it disclose the missing limitations of claim 22 from Bean.

Even if the references could be properly combined, Brunson, Bean, and Pause do disclose or suggest all of the limitations of independent claim 1, let alone dependent claims 4-9. Brunson discloses a miter saw with a handle that includes an arcuate outer surface, but does not include any structure that could rationally be considered to be a palm pad portion extending outwardly from the grip portion a distance sufficient to underline the heel portion of the palm of the user's hand. Similarly, Pause discloses a hand saw with a handle that is rotatable with respect to the saw blade. Pause does not disclose a miter saw, let alone specific structure of a handle of a miter saw. The missing limitations of Bean with respect to claim 1 are discussed above. Applicants respectfully request that the rejection be withdrawn.

For at least the reasons identified and discussed above, Applicants respectfully request that the rejections of record be withdrawn and the application be advanced to allowance.

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Respectfully submitted,



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